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Paper No.

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

MAILED

In re Application of : JUN 14 2010
Dorothy D. Lin, Rocco J. :
Brescia, Jr., Jen-Chieh Chien, : OFFICE OF PETITIONS
Adel F. Fanous, Alan Gin, and :
Mark R. Dale :
Application No. 10/661,648 : DECISION ON PETITION
Filed: September 12, 2003 : PURSUANT TO
Attorney Docket No. : 37 C.F.R. § 1.47(A)
2875.0120002 :
Title: HIGH SPEED DATA SERVICE :
VIA SATELLITE MODEM TERMINATION :
SYSTEM AND SATELLITE MODEMS :
:

This is in response to the petition pursuant to 37 C.F.R. § 1.47(a), filed January 7, 2004.

This petition is **GRANTED**.

On September 12, 2003, this application was filed, identifying Dorothy D. Lin, Rocco J. Brescia, Jr., Jen-Chieh Chien, Adel F. Fanous, Alan Gin, and Mark R. Dale as the joint inventors. On December 9, 2003, Applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted," requiring an executed oath or declaration in compliance with 37 C.F.R. § 1.63 and the surcharge for the late filing of the same. The notice set a two-month period for reply.

A grantable petition pursuant to 37 C.F.R. § 1.47(a) requires:

- (1) the petition fee of \$200;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 C.F.R. § 1.16(f);
- (3) a statement of the last known address of each non-signing inventor;

- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to each non-signing inventor for review and proof that each non-signing inventor refuses to join in the application or
 - b) proof that each non-signing inventor cannot be found or reached after diligent effort, and;
- (5) a declaration which complies with 37 C.F.R. § 1.63.

With this petition, Petitioner has asserted that Mr. Dale has refused to join this application¹ and has submitted the petition fee and the surcharge associated with the late submission of this petition, a declaration that has been executed by each of the joint inventors save Mr. Dale, and the last known address of the non-signing inventor.²

37 C.F.R. § 1.47(a)(4) requires proof that a complete copy of the application was sent to each non-signing inventor. The Tabandeh declaration of facts that was filed concurrently with this petition suggests, but does not explicitly state, that a complete copy of the application was included in the package that was sent to Mr. Dale's last known address on September 5, 2003.³ However, Petitioner has included cover letters that were included with mailings that were sent to the last known address of Mr. Dale on September 5, 2003 and September 19, 2003, and each mentions the inclusion of a copy of the application. The Office is therefore construing the language in the Tabandeh declaration of facts to mean that a complete copy of Application No. 10/661,648 was sent to the non-signing inventor. Petitioner must notify the Office if this is not a correct interpretation of the statement contained in this statement of facts.

Moreover, it is noted that the statement of the last known address, as well as both letters that were sent to the non-signing inventor contain the zip code 82652, whereas the correct zip code is 92652 (the declaration contains the correct zip code). However, the Tabandeh declaration of facts does not reveal if a response to the first mailing was received, and it sets forth that the second mailing was returned with a notation

¹ Petition, page 1.

² Petition page 2.

³ Tabandeh declaration of facts, paragraph 3.

that reads "unclaimed."⁴ As such, this statement of facts is being construed to contain a statement that no response was received to the first mailing, and both mailings were sent to the correct zip code, despite the typographical error which appears both in the statement of the last known address and on each cover letter. Petitioner must notify the Office if this is not a correct interpretation of the statement contained in this statement of facts.

It follows that pursuant to the above paragraphs, Petitioner has established that Mr. Dale was provided with a complete copy of the application, and has established that the non-signing inventor refused to execute the declaration.

Each of the requirements of 37 C.F.R. § 1.47(a) has been satisfied. This application is hereby accorded Rule 1.47(a) status. As provided in Rule 1.47, this Office will forward notice of this application's filing to the non-signing inventor at the address given in the declaration that was submitted concurrently with this petition. Notice of the filing of this application will also be published in the Official Gazette.

The Office of Patent Publication will be notified of this decision, and jurisdiction over this application is transferred to the Office of Patent Publication, so that this application can be processed into a patent.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.⁵ All other inquiries concerning the status of the application should be directed to the Office of Patent Publication at 571-272-4200.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

⁴ Tabandeh declaration of facts, paragraph 6.

⁵ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.



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Mark R. Dale
26962 Willow Tree Lane
Laguna Hills, CA 92653

In re Application of :
Dorothy D. Lin, Rocco J. :
Brescia, Jr., Jen-Chieh :
Chien, Adel F. Fanous, Alan :
Gin, and Mark R. Dale :
Application No. 10/661,648 : LETTER
Filed: September 12, 2003 :
Attorney Docket No. :
2875.0120002 :
Title: HIGH SPEED DATA :
SERVICE VIA SATELLITE MODEM :
TERMINATION SYSTEM AND :
SATELLITE MODEMS :
:

MAILED

JUN 14 2010

OFFICE OF PETITIONS

Dear Mr. Dale:

You are named a joint inventor in the above-identified United States patent application filed under the provisions of 35 U.S.C. § 116 (United States Code) and 37 C.F.R. § 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application, you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 C.F.R. § 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, the attorney of record below would presumably assist you. Joining in the application would entail the

filng of an appropriate oath or declaration by you
pursuant to 37 C.F.R. § 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3225. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to the Certification Division at (571) 272-3150 or 1-800-972-6382 (outside the Washington D.C. area).

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

cc: STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
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